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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,639	10/28/2003	Hiroshi Okada	17096.002001	5396
7590	02/26/2008		EXAMINER	
Jonathan P. Osha Rosenthal & Osha L.L.P. Suite 2800 1221 McKinney St. Houston, TX 77010			EVANS, KIMBERLY L	
			ART UNIT	PAPER NUMBER
			4143	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/695,639	OKADA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	KIMBERLY EVANS	4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 October 2003.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 28 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>4/13/06 and 10/28/03</u> .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 28 October 2003.
2. Claims 1-16 are currently pending and have been examined.

### **Information Disclosure Statement**

3. The Information Disclosure Statements filed on April 13, 2006 and October 28, 2003 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### **Specification**

4. The disclosure is objected to because of the following informalities: idiomatic and grammatically incorrect sentence structure. The disclosure contains sentences that are long and continuous, fragments, and incomplete sentence structure, hence, difficult to follow and/or understand the specification as written. The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

**Claim Rejections – 35 USC § 112 – 2<sup>nd</sup> Paragraph**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. The claims are generally narrative and indefinite, failing to conform with current U.S. practice.

They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Correction is required.
7. Claims 1, 3-6, 8-10, 12, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the limitation of country/region. The examiner cannot determine the metes and bounds. Clarification and correction is required.
8. Claims 9 and 10 recites the limitation "said receiving process." There is insufficient antecedent basis for this limitation in the claim.

**Claim Rejections - 35 USC § 101**

9. The following is a quotation of the first paragraph of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.
10. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The "recording medium" of Claim 1 is not a process, machine, manufacture, or composition of matter, or any improvement thereof. Replacing "recording medium" with "a computer-executable program tangibly embodied on a computer readable medium" is a suggestion for how to bring this claim into compliance with 35 U.S.C. 101

because "a computer-executable program tangibly embodied on a computer readable medium" is statutory subject matter.

### **Claim Rejections - 35 USC § 102**

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
12. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
13. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by: US Patent No 7,043,523 "Self-Adjusting Consumable Order-Assistance System and Method" issued May 9, 2006 to Haines et al, herein referred to as "Haines".
14. With respect to Claims 1, 8, and 12:

Haines discloses the following limitations:

- *a receiving process which receives from a user an input of a country/region where said printer is used* (referring to Figure 4, see at least column 9, lines 53-65: "...maintainer 251 interacts database 211 to determine when to replace consumables, what consumables to replace, alternative parts for peripheral devices, issue urgency, proactive warning of next issue(s), printer location and owner/contact information, printer model, serial number, etc., and impending maintenance notification...." and column 7, lines 18-20: "...maintainer comprises an individual whose job is to care for, maintain and feed (or replenish) a computer peripheral device...")
- *a storing process which stores a URL (Uniform Resource Locators) being associated with said country/region in the input thus received, with reference to data where the country/region and the URL are associated with each other in advance* (see at least column 6, lines 33-36: "...system indicates the part number of the consumable and provides a uniform resource locator (URL) which enables the user to ....")
- *an obtaining process which obtains information regarding a consumption degree of the consumable item used in the printer* (see at least column 8, lines 8-11: "...more users 48 of PC 12 interact with peripheral device 14 to obtain information on consumable levels, media levels and types...and referring to figure 3, column 8 lines 63-66: "...users 48 bi-directionally interact with devices 14, 114, and 214 to obtain consumable levels, media levels and types, warnings and/or notifications....")
- *an accessing process which accesses a Web site where the consumable item is purchasable, the Web site being identified by said URL thus stored, when the consumption degree meets a standard which is obtained by a predetermined rule* (see at least column 5, lines 26-28: "... communication link 18 comprises an electronic communication link that enables program 30 to submit a web page purchase using a web site of reseller 24.... and referring to Figure 3, column 8 lines 51-55: "...service provider 150 receives web information 46 from the Internet 23..." and referring to figure 2: "...the

user merely needs to click on the URL in order to cause the transfer of electronic shopping cart data list 38 to electronic shopping cart 138....")

15. With respect to Claims 2, and 13,

Haines discloses the following limitations:

- *said accessing process which accesses the Web site where the consumable item is purchasable is performed by an instruction from a user* (see at least column 5 lines 15-18: "...in one case, program 30 is designed to prompt a customer, or user, of PC 12 for authorization information before submitting an order for at least one consumable via Internet 23 with reseller 24.." and referring to figure 1, column 6 lines 35 & 36: ...enables the user to place an order via the PC and through the Internet with the reseller of the consumable and column 4 lines 25-30: "...electronic shopping cart data list 38 which provides a pre-formatted arrangement of data for an electronic shopping cart 138 within a web site of provider 24...")

16. With respect to Claim 3,

Haines discloses the following limitations:

- *said program allows the computer to execute said receiving process which receives from the user the input of the country/region where said printer is used,* (referring to Figure 4, see at least column 9, lines 53-65: "...maintainer 251 interacts database 211 to determine when to replace consumables, what consumables to replace, alternative parts for peripheral devices, issue urgency, pro-active warning of next issue(s), printer location and owner/contact information, printer model, serial number, etc., and impending maintenance notification....")
- and said storing process which stores the URL being associated with the country/region in the input thus received, at a time when said program is installed (see at least column 4, lines 22-30: "...consumable order assistance computer program 30

comprises an electronic shopping cart data list 38 which provides a pre-formatted arrangement of data for an electronic shopping cart 138 within a website of provider 24...such as order information identifying a consumable and order location information for the consumable...")

17. With respect to Claim 4,

Haines discloses the following limitations:

- *said program allow the computer to execute a process for receiving an input of the URL, instead of said receiving process which receives from the user the input of a country/region where said printer is used, and allows the computer to execute a process for storing the URL thus received, instead of said storing process which stores the URL being associated with the country/region in the input thus received.* (see at least column 6, lines 36-38: "...the user merely needs to click on the URL in order to cause the transfer of electronic shopping cart data list 38 to electronic shopping cart 138 and referring to figure 4, column 7 lines 12-14:"...an electronic URL link can be provided to the purchaser, indicating a place for ordering a consumable....")

18. With respect to Claims 5, 9, and 14,

Haines discloses the following limitations:

- *said receiving process which receives from the user the input of the country/region where said printer is used displays the country/region in selectable manner, based on said data where the country/region and the URL (Uniform Resource Locators) are associated with each other in advance* (referring to Figure 4, column 6 lines 64-66:"...a professional information technology (IT) department is shown....a centralized order-assistance tool was installed with environment 300...and column 7 lines 7-11: "...the notification includes information on which consumables need to be replenished...and

locations where the purchaser can place an order for the consumables...for example an electronic URL link....")

19. With respect to Claims 6, 10, and 15:

Haines discloses the following limitations:

- *execute a process which obtains country information set in said computer, and said receiving process which receives from the user the input of the country/region where said printer is used displays the country/region under a condition that a country corresponding to the country information thus obtained is being selected* (see at least column 4, lines 61-67 and column 5 lines 1-6: "...in operation, consumable order assistance computer program 30 is configured to receive a notification 44 from peripheral device 14 via messaging system 40 of a need to order a particular consumable alert a user of PC 12 of notification44 and provide an order location to the user for the consumable....")

20. With respect to Claims 7, 11, and 16:

Haines discloses the following limitations:

- *said consumable item is an ink cartridge, and the consumption degree of said consumable item is expressed by an ink remaining amount* (see at least column 1, lines 55 and 56: "...toner supply cartridges, ink, and ink reservoirs...and column 2 lines 30-34:...a computer-implemented self-adjusting consumable order-assistance system is provided which implements a program in which consumable components of computer peripheral devices are replenished...and lines 29-32 as noted in example given, "...the consumable order-assistance system then prompts the user using the printer driver 25 (see Figure 1), or the user is notified during the print job that the printer is running out of toner....and column 8 lines 15-25: ...Decision maker 50

interacts with peripheral device to determine when to replace consumables...what consumables to replace...usage and/or depletion rate...")

### **Conclusion**

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Hayward et al., US Patent No 7,013,092 B2 "Supply Ordering Status" issued March 14, 2006. Reference teaches an automatic ordering system for consumable components or replacement parts of a machine.
- Esterri, Pere, European Patent Application No EP 1,182,039 A1, "Printer Apparatus and Method" filed August 14, 2001. Reference describes a printer with network interface and database identifying and providing utilization instructions of a consumable. Interface for updating can be via user command or via Internet.
- Manchala et al., US Patent No 6,405,178 B1, "Electronic Commerce Enabled Purchasing System" issued June 11, 2002. Reference describes a computer system for auto ordering "consumables for a printer via a set of rules from one or more vendors.
- Claremont et al., US Patent No 7,124,097 B2 "Method and System for Ordering a Consumable for a Device" issued October 17, 2006. Reference describes a method for ordering one or more consumables for a device to one or more suppliers via a selectable consumable ordering system.

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22. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** can be reached at **571.272.6710**.
  
23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see [<http://portal.uspto.gov/external/portal/pair>](http://portal.uspto.gov/external/portal/pair). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks Washington, D.C. 20231** or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/Kimberly Evans/Examiner, Art Unit 4143

February 14, 2008

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143